

REMARKS

Claims

Claims 1-12, 14-17 are all the claims pending in the application.

35 U.S.C. § 112 Rejection

Claims 14 and 15 have been rejected under 35 U.S.C. § 112, second paragraph. In the Office Action it is alleged that claims 14-15 are indefinite because they allegedly fail to conform with current U.S. practice and they allegedly are replete with grammatical and idiomatic errors. See Office Action page 2.

Applicants submit that claims 14 and 15 comply with 35 U.S.C. § 112, second paragraph and are not indefinite. Applicants further submit that claims 14 and 15 are not replete with grammatical and idiomatic errors as asserted in the Office.

Applicants respectfully request the Examiner to specifically point out any grammatical or idiomatic errors the Examiner believes are present in the claims.

35 U.S.C. § 101 Rejection

Claims 14 and 15 have been rejected under 35 U.S.C. § 101 as not directed to patentable subject matter, because the claims allegedly do not recite a tangible result. Applicants submit that claims 14 and 15 clearly comply with 35 U.S.C. § 101.

Claims 14 and 15 recite a computer-readable storage medium storing a program which clearly falls within one of the classes of statutory subject matter, namely an article of manufacture. The Examiner has identified no exception that would cause these claims to fall outside the ambit of § 101, thus, there is no need to determine whether the claimed invention

would produce a useful, concrete and tangible result. As the Interim Guidelines issued by the PTO acknowledge, such a claim is directed to statutory subject matter and complies with § 101.

Further, “the burden is on the USPTO to set forth a *prima facie* case of unpatentability. Therefore if the examiner determines that it is more likely than not that the claimed subject matter falls outside all of the statutory categories, the examiner must provide an explanation”. See page 16 of the 2005 Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility. “The examiner bears the initial burden of presenting a *prima facie* case of unpatentability.” In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Applicants submit that the USPTO has not set forth a *prima facie* case of unpatentability.

Even if the Examiner deems claims 14 and 15 as exceptions to patentable subject matter, Applicants submit that claims 14 and 15 produce a useful, concrete and tangible (“real-world”) result. This is because the claims are directed to a mobile agent, transferring a place code between a portable device and a server, and creating an environment within a portable device based on the place code. Creating an environment allows a mobile agent to accomplish certain functions on the portable device. Hence, a skilled artisan would understand that a tangible change occurs at the portable device as an environment is created in which the received mobile agent can be executed.

Therefore, withdrawal of the rejection is respectfully requested.

Prior Art Rejections

Claims 1-3, 5, 7-9, 11-17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Walsh (U.S. Patent Number 6,233,601 B1) hereinafter “Walsh”, in view of Yokoyama et al. (Japanese Publication 2001/282756) hereinafter “Yoko”.

For *at least* the following reasons, Applicants respectfully traverse the rejection.

Applicants submit that Yoko does not serve as prior art, and hence, cannot serve as a basis to reject the claims of the present patent application. Applicants note that a verified English translation of the foreign priority document, JP 2001-039884, for the present application was received by the Patent Office on February 6, 2006. As the priority date (February 16, 2001) of the current patent application is before the Japanese publication date of Yoko (October 10, 2001), Applicants submit that Yoko does not anticipate the rejected claims. Applicants submit that the Japanese filing date of Yoko is irrelevant as to whether Yoko qualifies as prior art because under 35 U.S.C. § 102, a foreign reference is prior art as of its earliest publication date, not the filing date in a foreign country. See MPEP § 2136.03 citing In re Hilmer, 359 F.2d 859, 149 USPQ 480 (CCPA 1966), MPEP § 2132, and MPEP § 2133.

Accordingly, the Examiner is respectfully requested to withdraw the rejection.

Claims 4, 6, and 10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Walsh, in view of Yoko and further in view of Smith et al. (U.S. Patent Number 6,532,543 B1) hereinafter “Smith”.

Applicants respectfully traverse the rejection, since Yoko does not qualify as prior art.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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